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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,392

12/13/2005

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01/06/2009

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,392	Applicant(s) MULLER ET AL.	
	Examiner ANISH DESAI	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I claims 2-13 and 27 in the reply filed on 09/30/08 is acknowledged. However, based on Applicant's amendment, the restriction requirement is withdrawn and accordingly all claims are examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. **The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. As a result, the Examiner is having difficulty in ascertaining the structure and chemistry of Applicant's claimed product.**

4. For example, regarding claims 1 and 2, it is not clear as to what is meant by "system" or "security element". Further, preamble of claim 1 is drawn to a "System for the optically...and the like". However, the body of the claim recites that the coating is applied on the data carriers, valuable documents and etc. Thus, it is not clear as to how

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the system is related to the data carriers, valuable documents etc. Further, the claims recite the phrases such as "and the like", which are vague because it is not clear as to what is covered by "and the like". Further, the claims recite "a defined property", without providing any guidance as to what is meant by "defined property".

5. Moreover, regarding claims 5 and 17, it is not clear as to whether Applicant's coating includes **all** of the recited elements (i.e. Al, Cu, Fe, color pigments, malachite etc.) or it includes one of the recited elements.

6. Regarding claims 6 and 22, these claims recite "functional layers". It is not clear as to what is meant by "functional layers". What function does Applicant's layer perform?

7. Regarding claims 7 and 19, these claims recite "security elements", whereas the parent claim from which these claims depend recite "security element". Thus, the preamble of these claims is inconsistent with the parent claims, and it is not clear whether Applicant is claiming plural security element or single security element. Further, these claims recite "positive or negative printing"; it is not clear as to what is meant by the aforementioned recitation.

8. Regarding claims 10 and 22, these claims recite "**possibly** functional and/or decorative layers". It is respectfully submitted that recitation "possibly" is vague because it is not clear whether Applicant is positively claiming functional and/or decorative layers.

9. Regarding claims 11 and 23, these claims recite "the lamination adhesive", there is insufficient antecedent basis for this limitation in claims.

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10. Regarding claims 13 and 25, there is insufficient antecedent basis for the limitation "the adhesive" in claims.

11. Further regarding claim 29, it is not clear as to what is meant by "system for colour identification of the value or other properties...of a pack.". It is not clear as to what value or other properties Applicant is referring to.

International Search Report

12. Applicant has provided the international search report citing EP 0159828A1 and GB 2033839A as "X" reference. The Examiner has reviewed aforementioned reference but not agreed with the citation of the ISR because the aforementioned documents do not teach "wherein the coating comprises...and wherein a surface relief structure including...is fully or partially metallized" as presently claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Curiel (US 5,913,543).

14. Regarding claim 1, it is noted that claim recitation of "System for the optically simply...or the pack" is interpreted as an intended use of the "System". Specifically, the

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recitation "for the optically simply detectable and...the pack" is an intended use of the "system". Therefore, the recitations related to the coating and surface relief structure are not considered to be a structural part of the claimed "system". Accordingly, Curiel's disclosure of a tamper evident and counterfeit resisting informational article is equated to Applicant's "System". Thus, Curiel reads on Applicant's claimed invention (i.e. system). Further, regarding claim 2 recitation "Security element for application to and/or form at least partial...and the like" is interpreted as an intended use of the security element.

15. Alternatively, regarding claims 1, 2, and 14, abstract of Curiel discloses following:

The present invention is directed toward a tamper evident informational article such as a temporary vehicle registration which may be made of paper or paperboard. The informational article has a zone for inserting information and a pattern within said zone which will resist effective counterfeiting. A transparent tape which preferably has a silicone resin coating which contains a wax is adhesively secured over information contained within the zone. In other embodiments, an alteration resistant article contains variable data and includes an outer film having an upper surface and a lower surface with an adhesive secured to the lower surface. A hologram for receiving at least a portion of the variable data on the upper surface is secured to the outer film lower surface and, in one embodiment, the hologram has portions which have release properties and portions which have greater adhesive bonding properties than the release containing portions. These respective portions may be established by providing a release material on certain portions of the upper surface of the hologram and providing adhesive enhancing materials on other portions of the hologram upper surface. The hologram may be embossed and have a metallized upper surface. A plurality of relatively small hologram particles may be provided in the outer layer and/or the adhesive layer. The hologram is secured to a substrate which, in one embodiment, has an upper surface printed with pattern means which are printed to a lesser depth than the variable data. In another embodiment, the hologram is provided as a unit with the outer film and overlies the variable data. Associated methods are provided. The invention may be employed in vehicle temporary registration permits, as well as in other uses.

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16. Additionally, at column 3 lines 50-55 and at column 10 lines 40-50, Curiel discloses following respectively:

17. At column 3 lines 50-55:

Unlike prior art holograms, one feature of the present invention in an embodiment employing a metallized hologram, is that the metallized surface is disposed at the upper portion of the hologram and not the lower side.

18. At column 10 lines 40-50:

Referring to FIG. 10, another embodiment will be considered. In this embodiment, the hologram will be clear at least in part and will overlie the variable data. The variable data will underlie the hologram, rather than overlying it as in the embodiment of FIGS. 5 through 9. In this embodiment, a write-resistant layer 180 is secured to outer film 42 and layer 184 has portions of relative enhanced release properties and portions of relative enhanced adhesive properties. The embossed hologram 186 is transparent, but may, if desired, have a partially metallized underlying layer 188. A pressure sensitive adhesive layer 190 has a pair of

19. The aforementioned disclosure of Curiel with respect to providing partially metallized coating layer 188 and a metallized hologram is interpreted to read on Applicant's "wherein the coating comprises...metallized". Further, since claims do not provide any guidance as to what is meant by unambiguous assignment to a defined property, it is respectfully submitted that the disclosure of Curiel with respect to the coating of Curiel with metallized hologram would meet the aforementioned recitation since the system (security element and thin sheet material) of Curiel has same structure

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and composition as that of Applicant's system. Accordingly, Curiel anticipates presently claimed invention.

20. Claims 1, 2, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger et al. (US 6,165,592).

21. Abstract of Berger discloses following:

A document, for example a bank note, a check, a credit card, an identification document or a ticket, bears an optical safety mark in the form of a light-reflecting and light-diffracting and/or refracting layer, for example a hologram, an interference layer, a (computer-generated) refracting structure, located on at least parts of the document. The optical safety mark is arranged in a sandwich structure which is fixed to the document by means of an adhesive layer and if required has one or several transparent layers arranged in the sandwich structure. The adhesive layer and/or transparent layer in the sandwich structure is doped with at least one luminescent substance.

22. Further, at column 6 lines 5-15, Berger discloses a presence of metal layer that is disposed between an adhesive layer and a transparent layer.

23. The aforementioned disclosure of Berger is interpreted to read on Applicant's claimed coating.

24. Additionally, it is respectfully submitted that since claims do not provide any guidance as to what is meant by unambiguous assignment to a defined property, it is respectfully submitted that the disclosure of Berger with respect to the metal coating including hologram meets the aforementioned recitation of unambiguous assignment to a defined property since the system (security element and thin sheet material) of Berger has same structure and composition as that of Applicant's system. Accordingly, Berger anticipates presently claimed invention.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 1-4, 6-16, and 18-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Berger et al. (US 6,165,592).

26. Invention of Berger is previously disclosed and it is incorporated here by reference. As to the claim limitation of "coating which, by means of its coloration or by...to a defined property", it is reasonable to presume that said property is present in the coating of Berger.

27. Support for said presumption is based on the fact that the coatings of Applicant and that of Berger as set forth previously include same structure and composition. Further, the inventions of Berger and that of Applicant are in the same field of endeavor, e.g. a bank note etc. Therefore, the aforementioned feature would be present in the coating of Berger. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would

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obviously have been present once the coating of Berger is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977).

28. As to the claim limitation of "coating is applied by means of a PVD or CVD process", this is a product by process limitation. The product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

29. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

30. It is noted that as set forth previously the structure of the device of Berger includes a metal coating layer having a hologram. The Examiner sees no difference between Applicant's metal coating and that of Berger.

31. Regarding claims 6, 7, 18, 19, it is noted that Berger discloses presence of one or several transparent layers (abstract), which reads on functional layers. Additionally, Berger discloses "Basically the application of the optical security attributes with

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luminescing characteristics can be effected in any optional manner, For example, also by applying the layers of the layer composite 4 one after another." (column 5 lines 55-60). It is noted that the layer composite 4 includes a metal layer (column 5 lines 27-30). Thus, this metal layer is equated to Applicant's electrically conductive layers.

32. Regarding claims 8, 9, 20, and 21, it would have been obvious to provide varnish layer with pigments in it, motivated by the desire to enhance decorative effect of the security elements and the thin sheet material.

33. Regarding claims 10 and 22, Berger discloses "The optical safety mark is arranged in a sandwich structure which **is fixed to the document** [equated to carrier substrate] by means of an adhesive layer...in the sandwich structure." (see abstract).

34. Regarding claims 11-13 and 23-25, it is noted that Berger discloses that the adhesive layer is doped with at least one luminescent substance (abstract).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (US 6,165,592).

36. These claims as presently recited are interpreted that Applicant's coating includes all of the elements recited by "Al, Cu....colour pigments" and either azurite or malachite.

37. It would have been obvious to select all of the aforementioned elements including either azurite or malachite, motivated by the desire to enhance decorative effects of the coating by incorporating all of the various metallic elements and color pigments.

Conclusion

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Hai Vo/

Primary Examiner, Art Unit 1794